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10/608,414	11/24/2003	Peter J. Kight	23952-0058	8057
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SUTHERLAND II			BASIT, ABDUL	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,414	<b>Applicant(s)</b> KIGHT ET AL.	
	<b>Examiner</b> Abdul Basit	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/4/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

A person shall be entitled to a patent unless –

2. Claim 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor (US Pat. No. 5,220,501).

#### ***Regarding claim 1:***

Lawlor teaches a method of activating billers for a subscriber for electronic presentment of bills and for electronic payments, comprising:

- Receiving (i) first biller information identifying a first of a plurality of billers, (ii) second biller information identifying a second of the plurality of billers, and (iii) subscriber information associated with the subscriber; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Transmitting, to the first biller identified in the received first biller information, a request for verification of validity of the received subscriber information; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

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- Receiving, from the first biller, the verification of the validity of the first subscriber information responsive to the transmitted verification request; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- Activating (i) electronic presentment of bills of the first biller, based on the received verification of validity, and (ii) only electronic payment of bills of the second biller without verification of validity of the received subscriber information by the second biller, for the subscriber. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 2:**

Lawlor teaches a method according to claim 1, further comprising:

- Receiving payment information which a financial institution associates with a payment account of the subscriber; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Wherein electronic payment of bills of the second biller is activated for the subscriber based also on the received payment information (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 3:**

Lawlor teaches a method according to claim 2, wherein the subscriber information and the payment information are received concurrently. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 4:**

Lawlor teaches a method according to claim 1, wherein:

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- The subscriber information includes a first biller account number which the first biller associates with the subscriber, and a second biller account number which the second biller associates with the subscriber; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).and
- The request for verification of validity of the received subscriber information includes a request to verify the validity of the first biller account number and not the second biller account number. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 5:**

Lawlor teaches a method according to claim 1, further comprising:

- Transmitting, to the subscriber, a list identifying multiple of the plurality of billers; wherein the first biller is a first of the multiple billers, and the second biller is not one of the multiple billers; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Wherein the received first biller information is indicative of a selection of the first biller from the identified multiple billers in the transmitted list by the subscriber, and the received second biller information is typed information entered by the subscriber. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 6:**

Lawlor teaches a method according to claim 1, further comprising:

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- Receiving, from the subscriber, payment information that a financial institution associates with a payment account of the subscriber; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Activating electronic payment of bills of the first biller for the subscriber, based on the received payment information; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Wherein electronic payment of bills of the second biller is activated for the subscriber based also on the received payment information. (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 7:**

Lawlor teaches a method according to claim 1, further comprising:

- Receiving, from the subscriber, a request to be activated for electronic presentment of bills; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- Transmitting, to the subscriber, a list identifying multiple of the plurality of billers having bills available for electronic presentment in response to the request; wherein the first biller is a first of the identified multiple billers in the transmitted list; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Wherein the received first biller information is indicative of a selection by the subscriber of the first biller from the identified multiple billers in the transmitted

list. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 8:**

Lawlor teaches a method according to claim 7, wherein the activation request is a first activation request and the list identifying multiple of the plurality of billers is a first list, and further comprising:

- Receiving, from the subscriber, a second request to be activated for electronic payment of bills; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Transmitting, to the subscriber, a second list identifying multiple of the plurality of billers, including the first biller and the second biller, some of which have and some of which do not have bills available for electronic presentment, in response to the second activation request; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- Wherein the received second biller information is indicative of a selection of the second biller by the subscriber from the identified multiple billers in the transmitted second list. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*)

**Regarding claim 9:**

Lawlor teaches a system for activating billers for a subscriber for electronic presentment of bills and for electronic payments, comprising:

- A processor configured to receive (i) first biller information identifying a first of a plurality of billers, (ii) second biller information identifying a second of the plurality of billers, and (iii) subscriber information associated with the subscriber; and a memory configured to store the received first and the received second biller information and the received subscriber information; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- Wherein the processor is further configured (i) to direct, to the first biller identified in the received first biller information, a request for verification of validity of the received subscriber information, (ii) to receive, from the first biller, the requested verification validity of the received subscriber information responsive to the directed verification request, and (iii) to activate, for the subscriber, electronic presentment of bills of the first biller based on the received verification of validity, and only electronic payment of the second biller identified in the received second biller information without a verification of validity of the received subscriber information from the second biller. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 10:**

Lawlor teaches a system according to claim 9, wherein:

- The processor is further configured (i) to receive payment information that a financial institution associates with a payment account of the subscriber and (ii) to activate only the electronic payment of bills of the second bill for the



subscriber, based also on the received payment information; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and

- The memory is further configured to store the received payment information. (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 11:**

Lawlor teaches a system according to claim 10, wherein the processor is further configured to receive the subscriber information and the payment information concurrently. (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 12:**

Lawlor teaches a system according to claim 9, wherein:

- The subscriber information includes a first biller account number which the first biller associates with the subscriber, and a second biller account number which the second biller associates with the subscriber; (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- The processor directs the request for the verification of validity of the received subscriber information including the first biller account number and not the second biller account number. (see *abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 13:**

Lawlor teaches a system according to claim 9, wherein the processor is further configured (i) to receive, from the subscriber, payment information that a financial

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institution associates with a payment account of the subscriber, and (ii) to activate, for the subscriber, the electronic payment of bills of the first biller and the second biller, based on the received payment information. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 14:**

Lawlor teaches a system according to claim 9, wherein:

- The memory is further configured to store a list identifying multiple of the plurality of billers having bills available for electronic presentment; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- The first biller is a first of the identified multiple billers, and the second biller is not one of the identified multiple billers; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- The processor is further configured to direct the list to the subscriber; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- The received first biller information is indicative of a selection of the first biller from the identified multiple billers in the directed list, and the received second biller information is indicative of typed information entered by the subscriber. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 15:**

Lawlor teaches a system according to claim 14, wherein:

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- The processor is further configured to receive, from the subscriber, a request to be activated for electronic presentment of bills; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*) and
- The stored list is directed to the subscriber in response to the activation request. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

**Regarding claim 16:**

Lawlor teaches a system according to claim 9, wherein:

- The memory is further configured to store (i) a first list identifying multiple of the plurality of billers, including the first biller and not the second biller, having bills available for electronic presentment, and (ii) a second list of multiple of the plurality of billers, including the first biller and the second biller; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- The processor is further configured to (i) receive, from the subscriber, a first request to be activated for electronic presentment of bills, and to direct the stored first list to the subscriber responsive the received first activation request, and (ii) receive, from the subscriber, a second request to be activated for electronic payment of bills, and to direct the stored second list to the subscriber responsive to the second activation request; (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).
- The received first biller information is indicative of a selection of the first biller from the identified multiple billers in the directed first list; and the received second biller information is indicative of a selection of the second biller from the identified

multiple billers in the directed second list. (*see abstract, figs. 12, 14a-14d, column 33, lines 3-60, column 31, lines 50-58*).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes US Patents, 5,121,945; 5,496,991; 5,265,008; and 4,974,878.

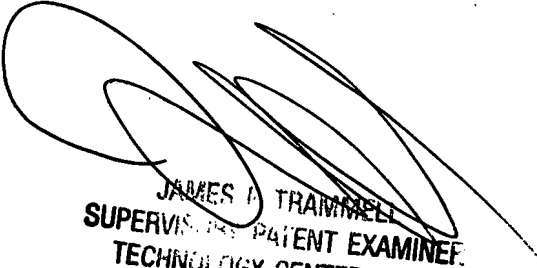
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdul Basit whose telephone number is 571 272-7246. The examiner can normally be reached on Monday - Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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